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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,298	08/08/2001	Vincent Bryan	46739/262600	3319

27683 7590 07/20/2006

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DALLAS, TX 75202

EXAMINER
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PHILOGENE, PEDRO

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/924,298

**Applicant(s)**

BRYAN ET AL.

**Examiner**

Pedro Philogene

**Art Unit**

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 114-119 is/are allowed.
- 6) ☒ Claim(s) 1-44,56-61,66-71,74-76,81,82,84-87,93-96,101-103,106-110,112,113 and 120-122 is/are rejected.
- 7) ☒ Claim(s) 88-92 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/15/06, 6/26/02</u> . | 6) <input type="checkbox"/> Other: _____  |

Continuation of Disposition of Claims: Claims pending in the application are 1-44,56-61,66,67,70,71,74-76,81,82,84-96,101-103,106-110 and 112-122.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 101-103, 106-110, 112-113 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/600,052. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims of the '298 application and claims 1-20 of the copending application lies in the fact that the copending application claims include many more elements and are thus more specific. Thus, the invention of claims 1-20 of the copending application is in effect a "species" of the "generic" invention of claims of '298 application. It has been held that the generic invention is "anticipated" by the "species" See *in re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims of the '298 application are anticipated by claims 1-20 of the copending application, they are not patentably distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-44, 66,67,70,71 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 7,025,787. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims of the '298 application and claims 1-22 of the patent lies in the fact that the patent claims include many more elements and are thus more specific. Thus, the invention of claims 1-22 of the patent is in effect a "species" of the "generic" invention of claims of '298 application. It has been held that the generic invention is "anticipated" by the "species" See in re Goodman, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims of the '298 application are anticipated by claims 1-22 of the patent, they are not patentably distinct.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 101-103, 106-110,112,113, 121,122 are rejected under 35 U.S.C. 102(e) as being anticipated by Viart et al. (FR 2,805,985).

With respect to claims 1101-103 106-110,112,113,121,122, Viart et al disclose a motion-preserving bone joint implant comprising a central body (1) and articuable between two shells (2,3), the central body having a resilient, deformable portion (4) and a coating material (5) encasing the central body wherein the resilient deformable portion allows motion in the joint implant and the coating material has a different hardness from the resilient, deformable portion; as best seen in FIGS.1-3.

Claims 56-61,81-82,84-85,93-96, 120, are rejected under 35 U.S.C. 102(e) as being anticipated by Steffee et al. (6,348,071).

With respect to claims 56, 59, 81, 85, 94,95,96, Steffee et al disclose a bone joint implant comprising a central body (200) positioned between two shells (20,120) has an upper and lower contact surface, and wherein in the absence of a compressive load, an upper shoulder is recessed into a portion of the perimeter of the upper contact surface and a lower shoulder is recessed into a portion of the perimeter of the lower contact surface; as best seen in FIGS. 1-5. and further wherein the upper shoulder defines a ledge, as best seen in FIG.5, indented into and around the perimeter of the upper contact surface of the central body. The shell has a first edge that includes a radial stop (146), as best seen in FIG.5, extending generally axially from a portion thereof, and wherein the first edge (144) has an outer circumferential groove, as best seen in FIG.5, therein and wherein the radial stop is adapted to contact a shoulder formed in the central body when translational, flexural, or extension forces are applied to the implant, wherein the radial stop is adapted to contact a shoulder formed in the central body when force are applied to the implant, the central body is bounded by an outer surface

and further wherein outer surface is impregnated with a surface hardening substance;  
as best seen FIG.4.

Claims 74-76 are rejected under 35 U.S.C. 102(e) as being anticipated by Mehdizadeh (6,231,609).

With respect to claims 74-76, Mehdizadeh discloses a bone joint implant comprising at least two opposing shells, as best seen in FIGS.5, 6, 12, a central body (43) disposed between the two opposing shells, at least one sealable opening (44, 68) for the introduction of a lubricant into the implant after the implant has been assembled.

Claims 86,87 are rejected under 35 U.S.C. 102(e) as being anticipated by Ralph et al. (5,989,291).

With respect to claims 86,87, Ralph et al disclose a bone joint comprising two shells interconnected by a sleeve (120) to form a cavity, and a central body (130) having at least one indentation (132) therein positioned within the cavity, wherein at least one of the shells includes a retaining post (204) that extends into the indentation and at least one of the shells includes an opening, as best seen in FIGS. 3b,4.

***Allowable Subject Matter***

Claims 88-92 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The indicated allowability of claims 1-44,66-67,70,71,74-76,86-92, is withdrawn in view of the newly discovered reference(s) to Mehdizadeh/Steffee et al/Viart et al/Ralph et al. Rejections based on the newly cited reference(s) follow (see above).

Claims 114-119 are allowed.

***Response to Amendment***

Applicant's arguments, see Remark, filed 5/9/06, with respect to the rejection(s) of claim(s) 56-61, 81, 82, 84, 85, 93-96, 101-103, 106-110, 112-113, 120-122 under 102/103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Mehdizadeh/Steffe et al/ Viart et al/ Ralph et al.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6,682,562	1-2004	Viart et al.
(FR 2,805,985 translation).		


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene  
July 13, 2006

  
PEDRO PHILOGENE  
PRIMARY EXAMINER